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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,395	03/13/2001	Harold E.A. Hansen II	16312-P001C1	7984

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EXAMINER	
CHOW, MING	
ART UNIT	**PAPER NUMBER**
2645	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/805,395	HANSEN ET AL.	
	Examiner	Art Unit	
	Ming Chow	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6,12,18-20,24-27,58-61 and 69-84* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6,12,18-20,24-27,58-61 and 69-84* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

1. In view of the Appeal Brief filed on 3-3-05, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Obviousness Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6252944. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 3 of the current application is broader than the claim 3 of Patent No. 6252944.

3. Claim 58 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 42 of U.S. Patent No. 6252944. Although the conflicting claims are not identical, they are not patentably distinct from each other because the calling and called telecommunication devices are obviously external to a telephone switching system.

4. Claim 69 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 46 of U.S. Patent No. 6252944. Although the conflicting claims are not identical, they are not patentably distinct from each other because the incoming call is obviously external to a telephone switching system. Each telecommunication device connects to a communication system is an extension.

5. Claim 70 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6252944. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the claim 70 of the current application is broader than the claim 1 of Patent No. 6252944.

6. Claim 72 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 46 of U.S. Patent No. 6252944. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed "a single processing means" is obviously the same as "not more than one microprocessor" of claim 46 of U.S. Patent No. 6252944.

Claim Objections

7. Claim 20 recites "the one processor". There is insufficient antecedent basis for this limitation in the claim.

Drawings

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "DTMF receiver" of claim 12, the

"recording buffer" of claim 20, the "circuitry for coupling a recording buffer in signal processing circuitry" of claim 20, the "switching circuitry" and "voice processing circuitry" of claim 1 (and other claims), the "a plurality of telecommunications devices coupled to the system" of claim 1 (and other claims), must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "off-hook state after the telecommunications device is connected to the call" is not clearly defined. It is unclear the "telecommunications device" is referred as a calling device or a called device.

10. Claims 27, 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the voice signal" (line 14) is not clearly defined. It is unclear the claimed "the voice signal" (line 14) refers to "a voice signal" (line 9) or "the recorded voice signal" (line 12).

11. Claim 71 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the plurality of telecommunications devices connected to the system as telephone extensions accessible solely through the switching circuitry" is not clearly defined. It is unclear what "switching circuitry" is referred to (see also drawing objections as stated above). Therefore, the patentability in view of this particular limitation cannot be determined.

Also, it is unclear what is referred by the "accessible". Any user can access (use) the telephone extensions without the switching circuitry unless a telephone call is made.

12. Regarding claim 83, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims 1, 69, 74, 80, 81, 84 are rejected under 35 U.S.C. 102(e) as being anticipated by Eisdorfer et al (US: 5960348).

For claims 1, 69, 81, Eisdorfer et al teach on Fig. 1, a telephone call and voice processing system.

Eisdorfer et al teach on items 105, 118, 116 Fig. 1, IXC switch (claimed "switching circuitry") includes a switch fabric and a voice processing unit (claimed "voice processing circuitry").

Eisdorfer et al teach items 169, 101, Fig. 1, a plurality of telecommunications devices and each comprises a speaker and a microphone.

Eisdorfer et al teach on steps 213, 215 Fig. 2, column 3 line 41-42, telephone stations are connected based on telephone number (claimed "information accompanying the call").

Eisdorfer et al teach on item 107 Fig. 1, column 4 line 23-31, main processor (claimed "not more than one microprocessor") controls the overall operation of IXC switch (including the switch fabric and the voice processing unit).

Regarding claim 74, see column 4 line 48-50 of Eisdorfer et al.

Regarding claim 84, items 169, 101 of Fig. 1 are separately operable telephone extensions.

Regarding claims 80, see column 4 line 48-50 of Eisdorfer et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al as applied to claim 1 above, and in view of Lohman (US: 5526397).

Eisdorfer et al failed to teach "voice processing circuitry comprises a signal processing circuitry". However, Lohman teaches on Fig. 4, column 12 line 7-9, a voice processor comprises digital signal processors (claimed "signal processing circuitry").

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "voice processing circuitry comprises a signal processing circuitry" as taught by Lohman such that the modified system of Eisdorfer et al would be able to support the system users conveniences of having a signal processing circuitry in the voice processing circuitry.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al, in view of Lohman, and further in view of Pinede et al (US: 4554413).

All rejections as stated in claims 1, 2 above apply.

Eisdorfer et al failed to teach "a digital cross-point matrix". However, Pinede et al teach on column 2 line 19-37, a telephone system connects a telephone stations via crosspoint matrix means.

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "voice processing circuitry comprises a signal processing circuitry" and "a digital cross-point matrix" as taught by Lohman and Pinede et al such that the modified system of Eisdorfer et al would be able to support the system users conveniences of having a DSP for voice processing and coupling multiple telephone stations by crosspoint matrix means.

16. Claims 18, 19, 24-27, 58-61, 71, 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al as applied to claim 1 above, and in view of Cho (US: 5544231).

All rejections as stated in claim 1 above apply.

Regarding claims 24, 25, 26, 58-60, 79, 83, Eisdorfer et al failed to teach "circuitry for listening.....;circuitry for activating a recording.....; circuitry for storing.....". However, Cho teaches on column 5 line 4-16, recording a telephone conversation (reads on claimed "circuitry for listening to a voice signal") by entering predetermined numbers via telephone dial keys or function buttons.

Cho teaches on Fig. 3, memory map for conversation recording. The memory must be a digital memory so that its map is in terms of "BYTES".

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "circuitry for listening.....;circuitry for activating a recording.....; circuitry for storing....." as taught by Cho such that the modified system of Eisdorfer et al would be able to support the system users conveniences of having circuitries for listening a voice signal, activating recording of the voice signal, and recording the voice signal in a digital memory.

Regarding claims 18, 19, see rejections as stated in claims 24, 25, 26.

When recording the conversation as taught by Cho, the calling and called parties must be on an off-hook state.

Regarding claims 27, 61, all rejections as stated in claims 1, 24, 25, and 26 above apply.

Cho teaches on column 2 line 4-7, playback and reproduce a previously recorded conversation (reads on claimed "voice signal originated from a voice mail message stored in the system").

Regarding claim 78, see column 4 line 48-50 of Eisdorfer et al.

Regarding claim 71, all rejections as stated in claim 27 above apply.

Eisdorfer et al in view of Cho failed to teach "a plurality of telecommunication devices connected to the system as telephone extensions accessible solely through the switching circuitry". However, "Office Notice" is taken that multiple telephone devices connected to a

switching system is old and well known to one skilled in the art. All calls to the telephone devices must go through the controlling switch solely for connecting the calls.

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al in view of Cho to have the "a plurality of telecommunication devices connected to the system as telephone extensions accessible solely through the switching circuitry" such that the modified system of Eisdorfer et al in view of Cho would be able to support the system users conveniences of connecting calls to telephone extensions solely via the switch.

Regarding claim 77, all rejections as stated in claim 27 above apply.

Regarding "trunk line", see column 4 line 48-50 of Eisdorfer et al.

17. Claims 73, 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al as applied to claim 1 above.

Eisdorfer et al failed to teach "the information is detected DTMF tones". However, "Official Notice" is taken that dialing a telephone number by pressing the telephone keypad for generating DTMF tones is old and well known to one skilled in the art.

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "the information is detected DTMF tones" such that the modified system of Eisdorfer et al would be able to support the system users conveniences of pressing telephone keypad and generating DTMF tones for addressing called party.

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al, in view of Van Berkum et al (US: 6028925).

All rejections as stated in claim 1 above apply.

Eisdorfer et al failed to teach "the single processing means is controlled by a single set of software". However, Van Berkum et al teach on column 3 line 37-39, a telephone switch with a control processor (claimed "single processing means") executes software programs to service the telephone calls. The collection of software programs is the claimed "a single set of software".

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "the single processing means is controlled by a single set of software" as taught by Van Berkum et al such that the modified system of Eisdorfer et al would be able to support the system users conveniences of controlling the single processing means by software.

Regarding claim 75, Eisdorfer et al in view of Van Berkum et al failed to teach "detected DTMF tones". However, "Official Notice" is taken that dialing a telephone number by pressing the telephone keypad for generating DTMF tones is old and well known to one skilled in the art.

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al in view of Van Berkum et al to have the "detected DTMF tones" such that the modified system of Eisdorfer et al in view of Van Berkum et al would be able to support the system users conveniences of pressing telephone keypad and generating DTMF tones for addressing called party.

19. Claims 12, 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al, in view of Newlin (US: 6011579).

All rejections as stated in claim 1 above apply.

Eisdorfer et al failed to teach "a signal processing circuitry includes a DTMF receiver". However, Newlin teaches on column 15 line 23-27, The voice processing DSP (claimed "signal processing circuitry") contains program to perform DTMF pulse detection (reads on claimed "DTMF receiver").

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "a signal processing circuitry includes a DTMF receiver" as taught by Newlin such that the modified system of Eisdorfer et al would be able to support the system users conveniences of detecting DTMF by the DSP.

20. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al, in view of Cho, and further in view of Newlin.

All rejections as stated in claims 1, 18, 19 above apply.

Eisdorfer et al failed to teach "circuitry for coupling a recording buffer". However, Newlin teaches on column 15 line 23-27, the DSP contains program memory and data memory (claimed "recording buffer"; recording program and data). There must be coupling circuitry to couple the memory and the DSP.

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "circuitry for coupling a recording buffer" as taught by Newlin such

that the modified system of Eisdorfer et al would be able to support the system users conveniences of having memories for recording.

21. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al, in view of Pinede et al (US: 4554413).

All rejections as stated in claim 1 above apply.

Eisdorfer et al failed to teach "a digital cross-point matrix". However, Pinede et al teach on column 2 line 19-37, a telephone system connects a telephone stations via crosspoint matrix means.

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "a digital cross-point matrix" as taught by Pinede et al such that the modified system of Eisdorfer et al would be able to support the system users conveniences of coupling multiple telephone stations by crosspoint matrix means.

22. Claim 72 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisdorfer et al, in view of Bertocci (US: 5953656).

All rejections as stated in claim 1 above apply.

Eisdorfer et al failed to teach "circuitry for monitoring a voice mail message while the message is being recorded". However, Bertocci teaches on column 1 line 65 to column 2 line 2, a telephone device allows a user to monitor incoming messages while the messages are being recorded.

It would have been obvious to one skilled at the time the invention was made to modify Eisdorfer et al to have the "circuitry for monitoring a voice mail message while the message is being recorded" as taught by Bertocci such that the modified system of Eisdorfer et al would be able to support the system users conveniences of monitoring messages while the messages are being recorded.

Conclusion

23. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Sakurai et al (US: 5586172) teach telephone exchange system.

24. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (571) 272-7535. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (571) 272-7547. Any inquiry of a general mature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

Art Unit 2645

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